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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/625,851	07/24/2003	Toshiyuki Hosokawa	107348-00358	8943

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ARENT FOX PLLC  
1050 CONNECTICUT AVENUE, N.W.  
SUITE 400  
WASHINGTON, DC 20036

EXAMINER
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NGUYEN, DONGHAI D

ART UNIT	PAPER NUMBER
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3729

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/16/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/625,851

Applicant(s)

HOSOKAWA, TOSHIYUKI

Examiner

Donghai D. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Response to Amendment***

1. The amendment filed on December 10, 2006 has been considered and made of record.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

3. Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation: "the cable comprises a single unbroken member" (claim 1, line 9) is unclear and confusing because it's not known as to what exactly being referred as "a single unbroken member". Further, it is noted that the claims directed to the process for mounting parts to the cable and the limitation recites "the cable comprises a single unbroken member" does not seem to further limit the claimed process.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) The invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-3 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 4,347,651 to Inoue et al.

Regarding claim 1, Inoue et al disclose a process for mounting a plurality of parts to a cable comprising: mounting the plurality of parts (18E and 18F) to the cable (20B) in mounted positions and mounted attitudes (see Fig. 6), the mounted positions being intermediate between opposite ends of the cable in a state where the cable is used (note the ends of the cable is exposed outside the parts), the mounted positions and the mounted attitudes being determined respectively for the parts, and marking the cable with information (123-XY-1, etc.) for the mounting of each of the parts before the mounting of the parts (See Col. 2, lines 33-54), further regarding the cable is being a single unbroken member as best understood that Fig. 6 of the Inoue et al shows the cable being made in a single form which readable on the claimed "a single unbroken member as claimed by the present invention.

Regarding claim 2, Inoue et al disclose the information comprises a name, the mounted position and the mounted attitude of each of the parts (see Col. 1, lines 16-19).

Regarding claim 3, Inoue et al disclose marking is carried out at a step of cutting the cable into a predetermined length (see Col. 2, lines 33-41).

6. Claims 1-3 as best understood are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent 5,153,839 to Cross.

Regarding claim 1, Cross discloses a process for mounting a plurality of parts to a cable comprising: mounting the plurality of parts (harness, terminator See Col. 9, lines 46-47) to the cable (see Fig. 6) in mounted positions and mounted attitudes, the mounted positions being

intermediate between opposite ends of the cable in a state where the cable is used, the mounted positions and the mounted attitudes being determined respectively for the parts, and marking the cable with information (64, 66, 68, etc. see Col. 9, lines 45-47) for the mounting of each of the parts before the mounting of the parts (see Col. 9, lines 45-52 and Fig. 10) wherein the cable comprises a single unbroken member (see Figs. 1, 6 and 10).

Regarding claim 2, Cross discloses the information comprises a name, the mounted position and the mounted attitude of each of the parts (see Col. 9, lines 45-47).

Regarding claim 3, Inoue et al disclose marking is carried out at a step of cutting the cable into a predetermined length (see Col. 9, line 49 to Col. 10, line 2).

#### *Claim Rejections - 35 USC § 103*

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4 and 5 as best understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Cross in view of US Patent 6,267,385 to Okamoto et al.

Cross does not disclose sliding at least one of the plurality of parts onto the cable and fixing to the cable at mounted positions by an adhesive. Okamoto et al teach the step of sliding mounting parts (10) onto the cable 14 and fixing the mounting part (10) to the cable by the adhesive (12) for easily fixing the mounting parts to the cable (see Col. 3, lines 9-12). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was

made to modify the invention of Cross by utilized the mounting method as taught by Okamoto above for easily fixing the mounting parts to the cable.

*Response to Arguments*

9. Applicant's arguments with respect to claims 1-5 have been considered but are moot in view of the new ground(s) of rejection.
10. Applicant's arguments filed December 19, 2006 have been fully considered but they are not persuasive. As stated in the Interview summary that the amendment appears to overcome the cited reference. However, after further consideration the amended claims raise new issues of 112 2<sup>nd</sup> paragraph, further the Inoue et al reference is still reasonable in the rejection of claims 1-3 (see above rejection).

*Conclusion*

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donghai D. Nguyen whose telephone number is (571)-272-4566. The examiner can normally be reached on Monday-Friday (9:00-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter D. Vo can be reached on (571)-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

DN

March 06, 2007

  
MINH TRINH  
PRIMARY EXAMINER